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EXAMINER

GLESSNER, BRIAN E

ART UNIT	PAPER NUMBER
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3635

DATE MAILED: 09/20/2002

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/878,214

Applicant(s)

DIAMOND, JEFFREY H.

Examiner

Brian E. Glessner

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 30 July 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-43 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 23-28 and 43 is/are allowed.
- 6) ☒ Claim(s) 1, 4-6, 20-22, 29-34, 37-39 and 42 is/are rejected.
- 7) ☒ Claim(s) 2, 3, 7-19, 35, 36, 40 and 41 is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 12 June 2001 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

## **DETAILED ACTION**

### ***Drawings***

1. The drawings are objected to as failing to comply with 37 CFR 1.84(p)(5) because they do not include the following reference sign(s) mentioned in the description: Reference number 225 is not in the figures as disclosed on page 22, line 13. A proposed drawing correction or corrected drawings are required in reply to the Office action to avoid abandonment of the application. The objection to the drawings will not be held in abeyance.

### ***Specification***

2. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means," "comprises," and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

### ***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 30-34 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

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In regard to claims 30 and 34, the scope of the claims is indefinite because, in claim 29, the applicant is claiming window structure where the elements are connected. This is proper since the applicant is claiming the finished structure. However, claims 30 and 34 do not claim the securing devices as being attached to the window structure because said claims use the term "for". This is improper because when claiming a structure all of the elements must be connected. Appropriate correction is required.

***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Weaver (5,669,191).

In regard to claims 1 and 29, Weaver discloses a compressible structure capable of temporarily protecting a glass pane of a window structure 16, 18 comprising a shaping member 30, 32, 34, 36 for removable securement on the window structure and defining a cavity over the glass pane, and a layer of solidified compressible material 38 (the material is at least compressible at 20, column 3, lines 43-44) in said cavity, figure 4, capable of providing protection for the glass pane. The examiner would like to note that although Weaver does not specifically disclose that his panel is for protecting the glass pane of the window, the examiner would like to point out that Weaver's panel contains all of the structural limitations of the claim.

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Therefore, Weaver's panel will inherently be capable of performing the same function as applicant's panel.

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 20-22, 37, and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver (5,669,191).

In regard to claims 20 and 21, Weaver discloses the claimed invention, except for specifically disclosing that said layer of solidified compressible material has a thickness in the range of 0.5 inch to 12.0 inches or more precisely 1.0 inch to 4.0 inches. However, Weaver does disclose that variations in size are deemed readily apparent and obvious to one skilled in the art, column 4, lines 17-24. Therefore, the examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to make Weaver's panel within the above range, since it has been held that where the general conditions of a claim are disclosed in the prior art, discovering the optimum or workable ranges involves only routine skill in the art. Further, the examiner contends that by making the panel within the above range, the insulation value would be increased, i.e. the thicker the panel, the higher the insulation value.

In regard to claim 22, Weaver discloses the claimed invention, except for specifically disclosing that the shaping member is adjustable in external size in response to a variation in the amount of said solidified compressible material in said cavity. However, the examiner would

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like to point out that Weaver does disclose that variations in size are deemed readily apparent and obvious to one skilled in the art, column 4, lines 17-24. Therefore, the examiner contends that one having ordinary skill in the art would be capable of using more compressible material to make the panel larger. The examiner takes note that Weaver supports his position by the statement referenced above. The examiner further contends that it has been held that the provision of adjustability, where needed, involves only routine skill in the art. Finally, the examiner takes the position that since windows come in many different sizes, the provision of adjustability is needed in this situation.

In regard to claim 37, Weaver discloses a method of placing a panel in a window structure comprising the steps of releasably securing a pre-formed panel of solidified compressible material over the glass pane (the panel is at least compressible at 20, column 3, lines 43-44), and removing the panel from the glass pane. Although Weaver does not specifically disclose that said panel is for protecting the window during a storm, wherein the panel is placed in the window before the storm and removed after the storm, the examiner contends that one having ordinary skill in the art at the time the invention was made would be capable of determining when the panel was placed in the window and when the panel was removed from the window as a matter of obvious design choice. Further, with respect to the protection of the window, the examiner contends that since Weaver's panel has the same structural limitations as applicant's panel, both panels will obviously act in the same manner.

In regard to claim 42, Weaver discloses the basic claimed method, except for specifically disclosing that the step of removing, includes the step of storing the panel for reuse. However, Weaver does disclose that the panel can be put in the window at night and taken out in the

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morning, abstract. Therefore, the examiner contends that when the panel is taken out during the day, it obviously must be stored somewhere. Therefore, the examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place Weaver's panel into a storage space during the day when the panel was not being used, because by placing the panel in a storage space, it will not be in the way.

9. Claims 4-6, 30-33, 38, and 39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Weaver (5,669,191) in view of Dearing (3,549,448).

In regard to claims 4, 5, 30, and 31, Weaver discloses the claimed invention, except for specifically disclosing the use of a securing element for removably securing said compressible structure on the window structure, wherein the securing element includes a releasable adhesive carried by said shaping member. Dearing teaches that it is known to releasably attach a sheet member to a window through the use of an adhesive carried by the sheet member, column 2, lines 10-12. The examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Dearing's teaching into Weaver's invention, because the adhesive will more securely hold the panel against the window. Therefore, the panel will be less likely to fall out of the window frame.

In regard to claims 6, 32, and 33, Weaver in view of Dearing disclose the basic claimed invention, wherein said compressible structure has an external perimeter. The examiner contends that the adhesive strip is a mechanical fastener. Weaver and Dearing do not specifically disclose that said securing element is interposed between said perimeter and the window structure. The examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place Dearing's adhesive means

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between Weaver's perimeter and the window structure, because the adhesive means will help to hold the panel in the window structure equally well if it were attached to either the side facing the glass or on the perimeter. Further, the examiner also takes the position that if the adhesive means were placed between the perimeter and the window structure, the compression from the part 20 of the panel would more securely push the adhesive against the panel and the window structure. Finally, the examiner contends that it has been held that the mere rearranging of parts of an invention involves only routine skill in the art.

In regard to claim 38, Weaver discloses the basic claimed method, except for specifically disclosing that the step of removably securing includes adhesively securing the panel to the glass pane. Dearing teaches that it is known to releasably attach a sheet member to a window through the use of an adhesive carried by the sheet member, column 2, lines 10-12. The examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to incorporate Dearing's teaching into Weaver's invention, because the adhesive will more securely hold the panel against the window. Therefore, the panel will be less likely to fall out of the window frame.

In regard to claim 39, Weaver discloses the basic claimed method, wherein said panel has an external perimeter. Weaver does not specifically disclose the step of placing one or more securing devices between the perimeter and the window structure. Dearing teaches that it is known to releasably attach a sheet member to a window through the use of an adhesive carried by the sheet member, column 2, lines 10-12. The examiner contends that it would have been obvious to one having ordinary skill in the art at the time the invention was made to place Dearing's adhesive means between Weaver's perimeter and the window structure, because the



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adhesive means will help to hold the panel in the window structure equally well if it were attached to either the side facing the glass or on the perimeter. Further, the examiner also takes the position that if the adhesive means were placed between the perimeter and the window structure, the compression from the part 20 of the panel would more securely push the adhesive against the panel and the window structure. Finally, the examiner contends that it has been held that the mere rearranging of parts of an invention involves only routine skill in the art.

***Allowable Subject Matter***

10. Claims 2, 3, 7-19, 35, 36, 40, and 41 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

11. Claim 34 would be allowable if rewritten to overcome the rejection(s) under 35 U.S.C. 112, second paragraph, set forth in this Office action and to include all of the limitations of the base claim and any intervening claims.

12. Claims 23-28 and 43 are allowed.

13. The following is a statement of reasons for the indication of allowable subject matter: Although the prior art references of record show some similar features as disclosed by applicant, they fail to show or teach the limitations as set forth in applicant's claims 2, 7, 23, 34, 35, 40, and 43. Claims 2 and 23 disclose the use of a port, claims 7, 34, and 40 disclose the use of a securing element including an attachment member and a clip having the particulars disclosed in claims 7, 34, and 40, claims 17 and 35 disclose a panel having different densities, and claim 43 discloses a method that the examiner does not believe is disclosed in the prior art.

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In regard to claims 2 and 23, the examiner would like to point out that although some of the prior art of record, i.e. Miller '595 discloses the use of a structure for temporarily protecting a window that has a port, the examiner would like to state that Miller's port is to allow air into the cavity. Although air is a compressible material, it is not a solidified compressible material. Air is fluid and not solidified. Further, the examiner would also like to point out that Bessler '035 discloses that flowable foam can be injected into a cavity through a port, figure 7. However, Bessler does not disclose that the foam is compressible. Bessler discloses that the foam is to be used as a window frame. Therefore, the examiner believes that if the foam is to be used as a window frame to hold a window, it would probably need to be rigid to hold the window in place. Therefore, even if Bessler and Miller were combined, they would not produce applicant's claimed invention of claims 2 and 23, nor would the combination of Weaver and Bessler or Miller. The examiner believes the above combination would not be proper because he has no proper motivation to add a port to Weaver's invention. Adding a port to Weaver's device would not allow one to place the panel in the cavity. Therefore, it would serve no function in Weaver's device.

In regard to claims 7, 34, and 40, the examiner would like to point out that although Carlson et al. '605 and Foster, Jr. et al. '439 show the use of a securing element having an attachment member and a clip, the examiner has not motivation to combine either of these references with Weaver. Weaver discloses that his panel could have a logo on the front of it for advertising. Therefore, the examiner believes that by using Carlson's or Foster's clips, they would interfere with the logo on Weaver's panel. Further, both of these fasteners appear to be

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permanent fasteners. Therefore, it would not be obvious to use a permanent fastener in a temporary system.

In regard to claims 17 and 35, the examiner would like to point out that although Reeves et al. '073 teaches the use of variable densities of foam can be used together, he does not disclose that said panel is used for the temporary protection of a window or the use of a shaping member that forms a cavity. To the contrary, Reeves' panel is used for marine purposes. Therefore, the examiner believes that there is no proper motivation to combine Weaver and Reeves.

In regard to claim 43, the prior art of record shows some similar features of applicant's claimed method, but they do not disclose the steps as specifically set forth in applicant's claim 43. Therefore, the examiner believes there is no proper motivation to combine the references of record to produce applicant's claimed method.

Finally, the examiner would like note the patents to Cowden et al. '934 and Pena '009. These patents are similar to applicant's claimed invention, but they lack two important limitations. First, they are both rigid panels, and second, they do not have a shaping member that forms a cavity. The examiner believes there is no proper motivation to modify these two references to meet the limitations of applicant's claims 2, 7, 17, 23, 34, 35, 40, or 43.

### ***Conclusion***

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Bessler, Reeves et al., Cowden et al., Pena, Ackley, Nesbitt, Pierre, Cheng et al., Rosenberg, Lightell, Land, Nally, Stafford, McCoy, Jr. et al., Downs, Intengan, Schuster et al., Carlson et al., Foster, Jr. et al., Dewitt, and Krahn.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Brian E. Glessner whose telephone number is 703-305-0031.

The examiner can normally be reached on Monday-Friday 7:00-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Carl D. Friedman can be reached on 703-308-0839. The fax phone numbers for the organization where this application or proceeding is assigned are 703-872-9326 for regular communications and 703-872-9327 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-2168.

B.G.  
September 16, 2002



**BRIAN E. GLESSNER**  
**PATENT EXAMINER**